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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/734,931
Filing Date: December 12, 2003
Appellant(s): WOehr ET AL.

Kevin Woehr et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/26/2008 appealing from the Office action mailed 4/8/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The objection to Claim 1 concerning the term "dimension" as being unclear.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,929,241	KULLI	5-1990
5,215,528	PURDY et al.	6-1993
5,549,570	ROGALSKY	8-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-22, and 33-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulli (U.S. Patent Number 4,929,241) in view of Purdy et al. (U.S. Patent Number 5,215,528) in further view of Rogalsky (US 5,549,570). Kulli discloses a medical needle puncture guard which teaches a needle protector clip (see figure 2 for example) comprising a proximal wall (near 13) with opening (11) for a needle (14), with a first and second resilient arm (15 or 16) which extend distally from the proximal wall and wherein both the first and second resilient arms have a first and second arm section (as in arm 16, first arm section is near area 16 to where it connects to 13; and the

second section is from 16 to the terminus area near 27), wherein the first arm section has a greater dimension than the second arm section dimension (see figure 2) and therein the first resilient arm crosses the second resilient arm at their respective second arm sections (as shown in figure 3 near points 29 which are situated on the second arm sections of the first and second resilient arms). Concerning claims 2-3 it is examiners position that Kulli element 30 is part of the clip and would be made of steel. Concerning claims 4-5 see width of element 13 as compared to element 26. Concerning claim 6 compare element 24 to 26 as in figure 3. Both the first and second resilient arms of Kulli have a distal wall (26 and 24 arm portions which overlap) with curved lips (unnumbered rounded portions extending therefrom as in figures 2 and 3). Concerning claims 11-12 it is examiners position that this clip is made from a unitary construction (see figure 1). Concerning claim 17, it is examiners position that the Kulli clip would function where the needle urges the arms radially outward (compare figure 2 to figure 3). Concerning claims 33-35 see side flaps with two side edges and a top edge shown in figure 5 (side edge leg area around 115 and 116). Concerning claims 36-43 see Kulli element 30 (or 130) and finger 25 and 27.

Kulli discloses the claimed invention except for where the needle protector clip is positioned and contacts in the interior cavity of a catheter hub that is attached to a needle hub with a needle with a bump or crimp. Purdy teaches that it is known to use a needle protector clip positioned and contacts in the interior cavity of a catheter hub that is attached to a needle hub with a needle with a bump or crimp as set forth in abstract and paragraphs at columns 2-6 and specifically describing clip 58 in figures 5a and 5b

to provide an effective means to cover the needle within a catheter needle assembly to prevent a "heath risk". It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Kulli with a needle protector clip positioned and contacts in the interior cavity of a catheter hub that is attached to a needle hub with a needle with a bump or crimp as taught by Purdy, since such a modification would provide the system with the needle protector clip is positioned and contacts in the interior cavity of a catheter hub that is attached to a needle hub with a needle with a bump or crimp for providing an effective means to cover the needle within a catheter needle assembly to prevent a "heath risk".

Kulli in view of Purdy discloses the claimed invention except for the arms that "intersect". Rogalsky teaches that it is known to use arms that "intersect" as set forth in figures 1, 3, 5 and paragraphs at columns 3-5, provide an engagement and biasing of the two arms against each other. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Kulli in view of Purdy with arms that "intersect" as taught by Rogalsky, since such a modification would provide the system with arms that "intersect" for providing an engagement and biasing of the two arms against each other.

(10) Response to Argument

Issue Number 1

The Appellant argues that the objection to claim 1 concerning the term "dimension" is clear and meets the requirements for definiteness. Applicant has stated

that a reasonable interpretation of claim 1 is that "the first dimension may refer to any of the length, the width or the thickness of the first arm sections, and the second dimension may refer to any of the length, the width or the thickness of the second arm sections" (see applicant's arguments page 4). Further applicant's state that "claim 1 is broad enough to cover many different configurations for the arm section" (Applicant's arguments page 4).

Examiner has withdrawn the objection to claim 1, and is giving the broadest reasonable interpretation to the term "dimension".

Issue Number 2

The Appellant argues that the examiner was incorrect concerning the rejection of Claims 1-22 and 33-47 as unpatentable under 35 U.S.C. 103(a) over Kulli (U.S. Patent Number 4,929,241) in view of Purdy et al. (U.S. Patent Number 5,215,528) in further view of Rogalsky (US 5,549,570). Applicant's argue that Kulli and/or Rogalsky does not disclose "a first and second resilient arms that intersect one another" and that intersection occurs 'at their second arm sections'.

It is Examiners position that both Kulli and Rogalsky disclose and teach "first and second arms that **intersect** one another at their second arm sections". Examiner is reading the term "intersect" to mean:

1. To cut across or overlap each other: *circles intersecting on a graph.*
2. To form an intersection; cross: *These two fences intersect at the creek.*

It is examiners position that the second arm sections intersect and this is shown in Kulli at figure 3 for instance where element second arm section 26 "overlap" and "cuts across" second arm section 24, and in Rogalsky in figure 3 and 4 for instance when element second arm section near 16'/16" intersects/"overlaps/cuts across second arm section member (near element 7). It is examiners position that this intersection does occur at "their respective second arm sections" since those second arm sections (identified above) have corresponding first arm sections that do not overlap.

Although applicant has not given a definition to the term "intersect" or "intersecting", the have inferred in there arguments that the term means "cut through or across one another" (see applicant's arguments page 9 line 25) Examiner is not taking the applicant's characterization of the term "intersect" to be limited to those terms. Examiner is taking the position that the term is broader.

Furthermore, in the two dimensional side view analysis of the figures shown in Kulli and Rogalsky may be difficult to see where exactly the second arm sections intersect but when viewed in three dimension or the physical devices it would be quite clear the exact intersection. For instance the gap near 7 of Rogalsky figure 3 and 4, is not a missing element but rather a pane or slice on side view where the two elements intersect

Applicant's further argue that there is not a motivation to combine Kulli and Purdy and Rogalsky. Examiner has provided motivations, "for providing an engagement and biasing of the two arms against each other". Biasing and engagement of the arms to a device is a very important function for an arm to have against a needle. Intersecting the

arms, as taught in Rogalsky and Kulli, would provide this biasing and engagement with the needle. Examiner has not stated that the motivation to intersect the arms is "to intersect the arms" (applicant's arguments page 10 lines 8-20), Examiner's position is that the intersecting of the arms is for providing an engagement and biasing of the two arms against each other. While there must be some teaching, reason, suggestion, or motivation that the references be combined to arrive at the claimed invention, there is no requirement that the references explicitly suggest the combination. The suggestion or motivation to combine the references or teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. Applicant's arguments merely address each reference in isolation, rather than what the prior art taken as a whole would have suggested to one of ordinary skill in the art. The prior art Kulli and Rogalsky clearly teach the use of intersecting second arm sections to position, configure, bias and engage the arms onto the needle. These are functions and spatial positions of the structures of the prior art which is taught by the intersecting teaching of Kulli and Rogalsky. (see above)

Applicant argues that claims 18-22 and 33-37 are also patentable for the same reasons and arguments set forth concerning claim 1. Examiner is of the same position and arguments as set forth concerning claim 1 concerning claims 18-22 and 33-37 (see above).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Phillip Gray/

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